

REMARKS

Claims 1-48 are pending in this application. Claims 1-4, 9-13, 17-25, 29, 31-35, and 39-48 stand rejected under 35 U.S.C. 102(e). Claims 21-23, 31, and 32 also stand rejected under 35 U.S.C. 103(a). Claims 5-8, 14-16, 26-28, 30, and 36-38 stand objected to for improper dependence. The Applicants would like to thank the Examiner for indicating that claims 5-8, 14-16, 26-28, 30 and 36-38 contain allowable subject matter.

The following remarks put the pending claims in condition for allowance. Applicants respectfully request reconsideration and the timely allowance of the pending claims. A favorable action is awaited.

35 USC § 102(e) Rejection

Claims 1-4, 9-13, 17-25, 29, 31-35, and 39-48 stand rejected under 35 U.S.C. 102(e) for allegedly being anticipated by Evans et al. (U.S. Patent No. 6,322,499, hereinafter “the ‘499 patent”).

The Examiner contends the ‘499 patent teaches each and every element of the invention of claims 1-4, 9-13, 17-25, 29, 31-35 and 39-48 of the instant application. Specifically, the Examiner contends that the first inner surface 38 has a substantially non-linear shape “because of the bent areas at the end portions”. Applicants respectfully disagree with the Examiner’s characterization.

Claims 1-48 of the instant application are directed to an illuminated surgical retractor comprising, *inter alia*, a first elongate inner surface extending from the first elongate proximal end portion to near the first elongate distal end portion having a

substantially non-linear shape. The non-linear nature of the inner elongate surface is one of the plurality of features that distinguish the retractor of the instant claims from the retractor described in the '499 patent. The Examiner's attention is respectfully directed to pages 19-25 of the instant specification where the Applicant describes both the nature and benefits of the non-linear shape of the first elongate inner surface of the instant invention. The Examiner's contention that "bent areas at the end portions" indicate a substantially non-linear shape of the inner elongate surface 38 is misplaced. The '499 patent simply does not teach this aspect of the instant invention. A review of the figures of the '499 patent clearly show that inner elongate surface 38 is in fact linear. Further, the text of the '499 patent indicates that the inner surface of the first elongate is linear. The Examiner's attention is respectfully directed to column 9, lines 54 to 60 of the '499 patent where the linear nature of the inner surface of the first elongate is described. Given the teaching of the instant application and that of the '499 patent it is clear that the '499 patent does not teach or suggest each and every limitation of claims of the instant application. Accordingly, the Applicants respectfully request that the rejection of claims 1-4, 9-13, 17-25, 29, 31-35, and 39-48 under 35 U.S.C. § 102(e) be withdrawn.

35 U.S.C. § 103(a) Rejection

Claims 21-23, 31 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leonard et al (U.S. Patent No. 6,554,768) in view of Hipps et al. (U.S. Patent No. 6,228,025). This rejection is respectfully traversed. Applicants respectfully put forth that the combined teachings of Leonard et al and Hipps et al do not contain each and every element of the claimed invention. Further, one of ordinary skill in the art

would not be motivated to combine these references in order to make the claimed invention.

The Examiner contends that Leonard et al teaches each element of the claimed invention with the exception of a handle member which forms an acute angle with the first elongate section. The Examiner further contends that this deficiency is cured by Hipps et al. Applicants respectfully disagree.

Claims 1-48 of the instant application are directed to an illuminated surgical retractor comprising, *inter alia*, a first elongate inner surface extending from the first elongate proximal end portion to near the first elongate distal end portion having a substantially non-linear shape. The non-linear nature of the inner elongate surface is one of the plurality of features that distinguish the retractor of the instant claims from the retractor described in Leonard et al. Once again, the Examiner's attention is respectfully directed to pages 19-25 of the instant specification where the Applicant describes both the nature and benefits of the non-linear shape of the first elongate inner surface of the instant invention. The Examiner's contention that the "bent areas at the end portions" indicate a substantially non-linear shape of the inner elongate surface 38 is misplaced. Leonard et al simply do not teach this aspect of the instant invention. A review of the figures of the Leonard et al clearly show that inner elongate surface 38 is in fact linear. It appears that the "bent areas at the end portions" upon which the Examiner relies to show the non-linear nature of first inner surface 38 are not part of inner surface 38 at all. The Examiner's attention is respectfully directed to column 7, lines 10 to 16 of Leonard et al which teaches that the "bent areas" are lip member 37 and shaft portion 35, not inner surface 38. Hipps et al does not address this deficiency in any way.

The Examiner's contention that it would be obvious to ordinary skill in the art to combine the teachings of Leonard et al with those of Hipps et al is also misplaced, as there is no motivation to combine the teachings of Leonard et al with that of Hipps et al. The Examiner asserts that one of ordinary skill in the art would form the handles and elongate members of the retractor of Leonard et al in an acute angle to one another, in view of Hipps et al, so that adequate pulling forces can be applied. There is no teaching in Leonard et al or Hipps et al regarding adequate pulling forces nor do they suggest altering the angle of the handles to the elongate members. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied upon as evidence of obviousness. See, e.g. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 217 F.3d 1365; 55 USPQ2d 1313 (Fed. Cir. 2000) Even when the level of skill in the art is high, the Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

It is respectfully submitted that the cited references do not provide sufficient teaching or disclosure to support the combination relied on by the Examiner for the obviousness rejection. There is no disclosure or suggestion in the references of the

claimed combination to support the combination created by the Examiner. Further, it is respectfully submitted that the Examiner has improperly used hindsight to recreate the claimed invention.

Given that the combined teachings of Leonard et al and Hipps et al do not contain each and every element of the claimed invention and that there is no motivation to combine these references the Applicants respectfully request that the rejection of claims 21-23, 31, and 32 under 35 U.S.C. § 103(a) be withdrawn.

35 U.S.C. § 112, Second Paragraph, Rejection

The Examiner has indicated in the section of the outstanding office action entitled “Allowable Subject Matter” that claims 5-8, 14-16, 26-28, 30, and 36-38 may be subject to rejections under 35 U.S.C. § 112, second paragraph. No such rejection were included in the office action, as such Applicants assume there are no current rejections under 35 U.S.C. § 112, second paragraph.

Claim Objections

The Examiner has indicated on the Office Action Summary accompanying the current office action that claims 5-8, 14-16, 26-28, 30, and 36-38 may be subject to certain objections. In particular, it appears from the office action section entitled “Allowable Subject Matter” that these claims might be objected to for being dependent upon certain rejected claims. Given the arguments presented above, Applicants respectfully put forth that any such objections are moot.

CONCLUSION

As all of the outstanding rejections have been addressed and all of the claims are believed to be in condition for allowance, the Applicants respectfully request a Notice of Allowability. The Examiner is invited to contact the undersigned representative should any further issues arise.

Respectfully submitted,

DECHERT LLP

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John W. Ryan

John W. Ryan
Reg. No. 33,771

Thomas M. Haas
Reg. No. 50,210

Dechert LLP
1775 Eye Street, N.W.
Washington, D.C. 20006
Telephone (202) 261-3375
Fax (202) 261-3333